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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,267	02/29/2000	Shiyan Hua	Cai-15-11	1804

7590 12/31/2002

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EXAMINER

KIDD, MARKY M

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/516,267

Applicant(s)

HUA ET AL. 

Examiner

Marky M Kidd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **1- 3, 13-15, and 25-27** are rejected under 35 U.S.C. 102(b) as being unpatentable by Dahlen (US Patent Number 5,870,454).

Regarding **Claim 1**, Dahlen discloses a telecommunications speech/text conversion and message delivery system that consist of the following steps:

- A. A plurality of telephonic devices for initiating and receiving telephone calls (column 2, lines 43-46 Figure 4 items 22 and 110);
- B. Providing an automated intelligent network (telecommunications network 20) for the automated processing of telephone calls in a telecommunication system, IN consisting of a service control point (SCP 40) that controls logic and asp database, and IN (telecommunications network 20) consisting of a plurality of switches coupled to telephone devices (Figure 1, column 2, lines 60-64, and column 1, lines 17-21);
- C. Via switches, routing calls authorized by SCP (SCP 40) to a destination number specified by a calling party (column 9, lines 29-33);
- D. Via IN (telecommunication network 20) and SCP (SCP 40), receiving an electronic mail (e-mail) message specifying a subscriber as the intended recipient of e-mail message (column 9, lines 33-40);
- E. Terminating a telephone call generated by IN (telecommunication network 20) to a telephone number specified by subscriber in SCP database (SCP 40 column 9, lines 42-44);
- F. Converting text in e-mail message to an audio message (column 9, lines 40-42); and

G. Transmitting telephone call, an outgoing message consisting of audio message (column 9, lines 44-45)

Regarding **Claim 13**, Dahlen discloses a telecommunications system that provides an audio message to a subscriber that has been converted from a text message that consist of the following steps:

A. A plurality of telephonic devices for initiating and receiving telephone calls (column 2, lines 43-46 Figure 4 items 22 and 110);

B. An automated intelligent network (telecommunications network 20) adapted to automatically process telephone calls in a telecommunication system, IN consisting of a service control point (SCP 40) consisting of a controls logic and an SCP database, and IN (telecommunications network 20) consisting of a plurality of switches coupled to telephone devices (Figure 1, column 2, lines 60-64, and column 1, lines 17-21);

C. A text-to-audio converter adapted to converting text in an electronic mail (e-mail) message to an audio message (column 9, lines 40-42);

D. Switches are adapted to route calls authorized by SCP (SCP 40) to a destination number specified by a calling party (column 9, lines 29-33);

E. IN (telecommunication network 20) and SCP (SCP 40) are adapted to receiving an electronic mail (e-mail) message specifying a subscriber as the intended recipient of e-mail message (column 9, lines 33-40);

F. IN (telecommunication network 20) is adapted to generating and terminating a telephone call to a telephone number specified by subscriber in SCP database (SCP 40 column 9, lines 42-44), and to cause to be transmitting during a telephone call, an outgoing message consisting of audio message (column 9, lines 44-45)

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3. Regarding **Claim 2 and 14**, Dahlen discloses a telecommunications method that consist of the following steps:

A. Comparing header information in e-mail message received by said SCP (SCP 40) to e-mail handling instructions stored in said SCP database (SCP 40) which is obvious in the art that in order to send an e-mail that the header is necessary. Therefore, this limitation is rejected.

B. Routing e-mail message to the telephone number specified by the intended subscriber when handling instructions so indicate (column 9, lines 35-36).

Regarding **claim 3 and 15**, Dahlen discloses a telecommunications method that consists of handling instructions that are customizable by subscribers (column 10, lines 29-31).

Regarding **claims 25, 26, and 27** the telecommunication system that consist of a text-to-audio converter (speech/text converter figure 4, item 80) and the function of transmitting outgoing messages are subsumed by an intelligent peripheral integrated into a switch (column 3, lines 3-12), subsumed by a stand-alone intelligent peripheral (column 11, lines 29-33), or subsumed by an intelligent peripheral integrated into a Service Node (Figure 1 Item 40).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 4-8, and 16-20** rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlen in view of Hamrick et al (US Patent Number 6,466,653).

Regarding **claims 4 and 16**, Dahlen discloses a telecommunication system that has an intelligent

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network that converts text messages to audio messages and handles instructions that are customized by the subscriber; however, is silent on the issue of transmitting e-mail message in truncated according to truncation instructions specified by the subscriber. Hamrick discloses a method that allows a caller identification database that can format to display information based on truncated information (column 6, lines 63-67, and column 7, lines 1-8). Dahlen discloses the method of converting text to audio and handling instructions given by the subscriber, and it would have been obvious to one skilled in the art to use the caller identification database of Hamrick in order to truncate e-mail messages sent according to the subscribers instructions.

Regarding **claims 5 and 17**, Dahlen discloses a telecommunication system that operates on an intelligent network in the conversion of text messages to audio messages; however, is silent on the issue of determining if a subscriber has Caller Identification service, and providing the Caller ID information to the subscriber for the indication of an e-mail message. Hamrick discloses a text-to-speech conversion of Caller's ID for the intention of a telephonic device that checks the parameters to determine if the called party has caller id capability's (column 6, lines 50-54 and column 11, lines 31-38). It would have been obvious to one in the art to combine the telecommunication system of Dahlen with the conversion of Caller ID of Hamrick to in order for e-mail messages converted to audio will have the Caller information attached and check to see that the subscriber can accept the message.

Regarding **claims 6, 7, 8, 18, 19, and 20** Hamrick discloses a method that allows Caller ID information to consist of the identity of the e-mail sending party, the subject matter identifier of the e-mail message, and a portion of the text of the e-mail message (column 7, lines 1-8).

6. **Claims 11 and 23** rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlen in view of Srinivasan (US Patent Number 6,072,862). Dahlen discloses a telecommunications system that consist of intelligent network that allows text to audio conversion to a telephonic device; however, is silent on the issue of allowing a subscriber to enter a code instructing the system to store the audio message in a voicemail box upon receiving the code. Srinivasan discusses a system that allows for the subscriber to preselect the destination of

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messages (column 4, lines 41-45). It would have been obvious to one skilled in the art to combine the telecommunication system of Dahlen with the preseletion of a plurality of destinations of Srinivasan in order to allow subscribers choices for messages.

7. **Claims 9, 10, 21, and 22** rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlen in view of Shaffer et al (US Patent Number 5,995,594).

Regarding **claims 9 and 21**, Dahlen discloses a telecommunications system that consist of intelligent network that allows text to audio conversion to a telephonic device; however, is silent on the issue of sending a distinctive ringing pattern corresponding the inclusion of an e-mail message in the telephone call. Shaffer discloses a telephone system that includes a method for providing different ring patterns that will distinguish different types of messages (column 3, lines 59-61). Dahlen discloses the system that allows for the text to audio conversion to a telephonic device, and it would have been obvious to one skilled in the art to include the different ringing pattern to identify different types of messages to the called party as described in Shaffer in the telecommunication system of Dahlen in order to provide a means of identifying telephone calls with e-mail messages.

Regarding **claims 10 and 22**, Dahlen discloses a telecommunications system that consists of an intelligent network for the purpose of converting text to audio to a telephonic device. The telecommunication system of Dahlen also allows for handling instructions that are customized by the subscriber. Dahlen; however, is silent on the issue of an e-mail message not transmitted to a subscriber unless the header information in the e-mail message indicates that the message is urgent. Shaffer discloses a telephone system that allows for different ring patterns to identifies to called parties that a message is urgent (column 3, lines 61-67). It would have been obvious to one skilled in art to modify the telecommunication system of Dahlen to include the ring patterns for urgent messages as described by Shaffer to help identify that e-mail messages being sent are urgent.

8. **Claims 12 and 24** rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlen in view of Qua et al (US Patent Number 6,222,909) in further view of Nabkel et al (US Patent Number 5,963,626). Dahlen

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discloses a telecommunication system that consists of converting text messages to audio messages that can be heard over a telephonic device. However, Dahlen is silent on the issue of prompting subscribers to enter a code that instruct the telecommunication system to repeat audio message upon receiving the code. Nabkel discloses a method that allows a subscriber to enter a Personal Identification Number in order to change communiqués that he/she wants to communicate with (column 1, lines 25-36). Nabkel also discloses a method that consist of an AIN network that uses a Intelligent Peripheral that can be used to prompt subscribers for entering a PIN (column 4, lines 61-67, column 5, lines 1-7, and claim 7). Qua discloses a method that allows audio messages to be replayed for users over a communication device (column 3, lines 61-63 and column 6, lines 51-54). It would have been obvious to one skilled in the art to modify the telecommunication system of Dahlen to include the method of Nabkel that allows for subscribers to enter PIN numbers for communication needs, and to include the method of Qua that gives the ability for audio messages to be replayed for users over a communication device. This modification would allow for a telecommunication system consisting of subscribers entering PIN's or codes in order to repeat or replay audio messages.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marky M Kidd whose telephone number is 703-305-8149. The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5403 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.



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Marky M Kidd  
Examiner  
Art Unit 2645

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December 30, 2002



SCOTT L. WEAVER  
PRIMARY EXAMINER

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